

**EXAMINING GROUP 2416**  
**PATENT**

**II. The 35 U.S.C. § 103(a) Rejections Fail to Properly Determine the Scope and Content of the Prior Art, and Are Therefore Improper**

**A. The Claim Rejections Include Contradictory Statements**

In rejecting the claims under Section 103(a), the Examiner makes contradictory statements, thus improperly determining the scope and content of the prior art.

For example, in discussing claim 1, the Examiner states, “Eng. et al. do not expressly disclose: . . . the request comprises a time limit information indicating a deadline for the distribution of the contents information file.” Final O.A. at 4. Applicant agrees with this statement. However, in discussing claim 25, the Examiner states exactly the opposite: “Eng. et al. disclose . . . the request signal including the time limit information indicating a deadline for the distribution of the content information file.” Final O.A. at 11. Applicant disagrees with this statement, as discussed further below.

Based on these contradictory statements, the Examiner has clearly failed to properly determine the scope and content of the prior art, and has thus failed to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a).

**B. None of the Prior Art References Disclose or Suggest the Recited “Request”**

Independent claim 1 recites, among other things, a server apparatus that includes a transceiver for receiving a request signal from a terminal apparatus and a first controller for scheduling a distribution time period in which requested contents information file is distributed. Claim 1 further recites that “the request signal comprises time limit information indicating a deadline for the distribution of the contents information file,” and “the first controller schedules the distribution time period based on the deadline for the distribution and the state of the communication line.”

In rejecting claim 1, the Examiner admits that Eng does not disclose these features, and relies on col. 7, l. 64 - col. 8, l. 15 and col. 14, ll. 2-10 of Eggleston as disclosing these features. See Final O.A. at 4-6. The Examiner's assertion with regard to Eggleston is incorrect. Column 7, line 64 - column 8, line 15 of Eggleston states the following:

This object/message may be created in response to a preceding client generated message (e.g., a request generated when clicking on an application button requesting updates, executing the mail application, etc.), or in response to settings in the client profile. However, after updating the active client profile/object for an active client application, the query manager is preferably programmed to send query objects at predetermined intervals for each application being run by each active client, the intervals varying depending on the application type (e.g., longer for mail about every 5\*\*\*\* seconds) than for interactive applications like Lotus Notes (about every 1\*\*\*\* second).

This passage fails to disclose or suggest a request signal comprising time limit information indicating a deadline for the distribution of the contents information file, as recited in claim 1. The passage merely recites a "request" without further elaborating on what is included in the request, and further recites sending "query objects" but does not describe what is included in the query objects.

Column 14, lines 2-10 of Eggleston also fails to disclose the request or first controller recited in claim 1. Rather, this portion of Eggleston recites the following:

In estimating the transmission value (e.g., cost), a rate governor could better estimate actual costs by taking into account known pricing factors established by each network service provider (e.g., rates by time of day, by grade/quality of service (QoS) for packets, by size of bandwidth desired, etc.). These values would be maintained for application by the rate governor (234 of Fig. 2) as each data unit is received to determine an estimated transmission value).

This passage fails to recite or discuss requests at all.

Therefore, under any reasonable interpretation, Eggleston fails to disclose a request signal that “comprises time limit information indicating a deadline for the distribution of the contents information file,” as recited in claim 1. Consequently, Eggleston further fails to disclose that “the first controller schedules the distribution time period based on the deadline for the distribution and the state of the communication line,” as further recited in claim 1.

For at least the reasons discussed above, in rejecting independent claim 1 and its dependent claims 3-8, the Examiner has failed to determine the proper scope and content of the prior art, as required for a proper rejection under 35 U.S.C. § 103(a). See, M.P.E.P. § 2141. Thus, the rejection of claims 1 and 3-8 should be withdrawn.

Independent claim 9 recites, among other things, a controller for generating a request signal, wherein “the request signal comprises a signal including time limit information indicating a deadline for the distribution of the contents information file, and the distribution time period is determined based on the time limit information.” For at least the same reasons discussed above in connection with claim 1, the rejection of claim 9 and dependent claims 11-15 and 17 is improper and should also be withdrawn.

Claim 25 recites an information distribution method for transmitting a contents information file to a terminal apparatus based on a request signal from the terminal apparatus, and further recites “the request signal including time limit information indicating a deadline for the distribution of the contents information file.” After admitting that Eng fails to disclose this recitation, as discussed above, the Examiner later contends that column 6, lines 14-18 of Eng discloses the recited request signal. See Final O.A. at 11. The Examiner is incorrect. The cited portion of Eng states:

Thereafter, the end-user device starts a timer, and stays in the Request State 402 until the communications controller/scheduler 101 acknowledges reception of the Xmt\_Req signaling information by broadcasting its Access ID over the ACK channel 303.

Though this passage recites a "timer" and also recites a "Request State," it does not teach or suggest a "request signal [from a terminal apparatus] including time limit information indicating a deadline for the distribution of the contents information file," as recited in claim 25. Accordingly, in rejecting claim 25 and dependent claims 27-32, the Examiner has failed to determine the proper scope and content of the prior art, as required for a proper rejection under 35 U.S.C. § 103(a). See, M.P.E.P. § 2141.

### III. **Conclusion**

In rejecting the claims, the Examiner presents contradictory arguments, and improperly asserts that the cited references disclose the claimed subject matter. Because the claim rejections include legal and factual deficiencies with regard to the rejections under 35 U.S.C. § 103(a), and for at least the reasons discussed above, Applicant requests that the rejections be reversed and the pending claims be allowed.

Please grant any extensions of time required to enter this request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, L.L.P.

Dated: December 15, 2008

By: Bradley Edelman  
Bradley Edelman  
Reg. No. 57,648